

REMARKS

Claims 1-8 are pending in the application. Request for reconsideration is requested.

FINALITY OF PRESENT ACTION SHOULD BE WITHDRAWN

In partial response to the current Action, Applicants filed a Communication to the Examiner Requesting Withdrawal of the Final Office Action of October 4, 2004, Since Premature Under MPEP 706.07 And Issuance Of A New, Non-final Office Action Setting a New Response Period on December 6, 2004 (copy attached). As indicated in the Communication to the Examiner, the only amendments made to claims 1-4, in the Amendment filed July 8, 2004, were directed to an amendment for form only to the preamble of independent claim 1. Specifically, the preamble of independent claim 1 was amended for form only to recite "(a) bar code reader. . . , the bar code reader comprising. . . ." (Emphasis added indicating amendment).

Applicants submit that the Examiner's contention in item 7 of the current Action that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action" is not correct. Further, as set forth in MPEP §706.07(a) entitled "Final Rejection, When Proper on Second Action" a new ground of rejection is not made properly final when "the new ground of rejection is neither necessitated by applicant's amendment of claims" In addition, as set forth in MPEP § 706.07(d):

(i)f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

Conclusion

Accordingly, Applicants request the finality of the current Action be withdrawn and a new, non-final Office Action issued, setting a new response period based on the mailing date of the same.

ITEM 3: REJECTION OF INDEPENDENT CLAIMS 1 AND 5 (AND RESPECTIVE DEPENDENT CLAIMS 3 AND 7) UNDER 35 U.S. C. §103 OVER OGASAWARA IN VIEW OF NEWLY-CITED ART BUTTON (U.S.P. 5,786,584).

Independent claims 1 and 5 recite, respectively, a bar code reader having an arrangement to communicate with a host apparatus in a POS system, and a method, using claim 1 as an example, including "a read unit that reads a bar code attached to an article, and outputs bar code information corresponding to the read bar code; a term information acquisition unit that acquires term information included in the bar code information; a term expiration check unit that checks whether the term of the article has expired based on the term information; and a notification unit that notifies that the term of the article has expired upon determination by the

term expiration check unit that the term of the article has expired."

The Action concedes that Ogasawara does not teach features recited by independent claims 1 and 5 of "the barcode reader itself contains the equipment to be able to utilize the term information acquisition unit, term expiration check unit, and notification unit in addition to a read unit that reads the barcode." (Action at page 3).

Nevertheless, the Examiner rejects claims 1, 3, 5 and 7 under 35 U.S. C. §103 over Ogasawara in view of Button and contends that it would have been obvious to modify Ogasawara to have "a self-standing barcode reading system with all information received at the local apparatus." (Action at page 4).

Applicants submit that there is no reasonable chance of success to combine the features of the prior art in a manner as proposed by the Examiner. Ogasawara teaches (col. 3, lines 33-37) "a bar code scanner 12. In conventional fashion, the bar code scanner 12 picks up information." Ogasawara further teaches (col. 3, lines 55-60) that such a conventional scanner transmits information to a store platform computer 14 which redirects that information to the POS terminal 10.

Applicants submit there is no reasonable chance of success to modify such a conventional scanner as taught by Ogasawara to "employ a database in the memory of a barcode scanner" as taught by Button (see, for example, col. 2 lines 5-40).

Applicants further submit that there is no motivation to combine a system for managing expiration-dated products utilizing an electronic receipt as taught by Ogasawara with a nonanalogous reading device providing audio feedback for a blood glucose monitoring system as taught by Button, as the Examiner contends.

As provided in MPEP §2143 entitled Basic Requirements of a *Prima Facie* Case of Obviousness:

(t)he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Conclusion

Since there is no suggestion to make the claimed combination as the Examiner contends and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 3-5 and 11 allowed.

ITEM 4: REJECTION OF DEPENDENT CLAIMS 2 AND 6 UNDER 35 U.S. C. §103 OVER OGASAWARA AS MODIFIED BY NEWLY-CITED ART BUTTON FURTHER IN VIEW OF WAXELBAUM ET AL. (U.S.P. 6,308,893

Dependent claims 2 and 6 recite a bar code reader and a method, respectively, using claim 2 as an example, including "a timer unit that keeps record of present date, wherein the term expiration check unit checks whether the term of the article has expired based on a comparison of the present date with the term information, wherein the term information is set by giving consideration to time error."

The Action concedes that Ogasawara/Button does not teach features recited by dependent claims 2 and 6 of a bar code reader having "a timer unit that keeps record of the present data." (Action at page 5).

Nevertheless, the Examiner rejects claims 2 and 6 under 35 U.S. C. §103 over Ogasawara as modified by Button further in view of Waxelbaum et al.

Applicants submit that that the cited art alone, or in combination, does not teach a bar code reader with "a comparison of the present date with the term information, wherein the term information is set by giving consideration to time error." While Waxelbaum does teach (col. 9, lines 5-6) that a "clock 240 may be included in the circuitry of the reader," Waxelbaum merely teaches (col. 9, lines 6-10) that the clock is "to periodically awaken, the code reader . . . (or). . . so the code reader can be used as a time piece."

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)."

Conclusion

Since recited features of claim 2 and 6 are not taught by the cited art, alone or in combination, and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 2 and 6 allowed.

ITEM 4: REJECTION OF DEPENDENT CLAIMS 4 AND 8 UNDER 35 U.S. C. §103 OVER OGASAWARA AS MODIFIED BY NEWLY-CITED ART BUTTON FURTHER IN VIEW OF WAXELBAUM

Dependent claim 4 recites a bar code reader including "a date setting unit that sets a date of the timer unit using a date setting bar code." Dependent claim 8 recites a method "setting the present date in the timer unit using a date setting bar code."

The Action concedes that Ogasawara/Button does not teach these features but rather

that a "date setting bar code is employed for expiration date." (Current Action at page 6). Nevertheless, the Examiner rejects claims 4 and 8 under 35 U.S.C. §103 over Ogasawara as modified by Button further in view of Waxelbaum.

Applicants submit that that *prima facie* obviousness is not established since there is no reasonable chance of success to modify the conventional bar code reader as taught by Ogasawara to incorporate circuitry as taught by Waxelbaum for collecting a toll based on use, as the Examiner contends.

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 4 and 8 allowed.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Paul W. Bobowiec
Paul W. Bobowiec
Registration No. 47,431

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501